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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,811	07/28/2005	Larry Erickson	00270.0079USWO	7621

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MERCHANT & GOULD PC  
P.O. BOX 2903  
MINNEAPOLIS, MN 55402-0903

EXAMINER
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WORLEY, CATHY KINGDON

ART UNIT	PAPER NUMBER
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1638

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	03/14/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/519,811	<b>Applicant(s)</b> ERICKSON ET AL.	
	<b>Examiner</b> Cathy K. Worley	<b>Art Unit</b> 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, drawn to a method for isolating a harvest-inducible DNA sequence utilizing a cDNA library.

Group II, claim(s) 3 (in part) or claim 2, drawn to an isolated harvest-inducible cDNA; including a cDNA sequence comprising SEQ ID NO:1, a complement thereof, a fragment thereof, a complement of said fragment, a nucleic acid that hybridizes to SEQ ID NO:1, or a nucleic acid that hybridizes to the complement of SEQ ID NO:1.

Group III, claim(s) 3 (in part) or claim 2, drawn to an isolated harvest-inducible cDNA; including a cDNA sequence comprising SEQ ID NO:2, a complement thereof,

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a fragment thereof, a complement of said fragment, a nucleic acid that hybridizes to SEQ ID NO:2, or a nucleic acid that hybridizes to the complement of SEQ ID NO:2.

Group IV, claim(s) 3 (in part) or claim 2, drawn to an isolated harvest-inducible cDNA; including a cDNA sequence comprising SEQ ID NO:3, a complement thereof, a fragment thereof, a complement of said fragment, a nucleic acid that hybridizes to SEQ ID NO:3, or a nucleic acid that hybridizes to the complement of SEQ ID NO:3.

Group V, claim(s) 4-5, drawn to a method for isolating a harvest inducible regulatory element utilizing genomic DNA sequences.

Group VI, claim(s) 7 (in part) and claims 6, 8-13, 22, and 25-26, drawn to a harvest-inducible regulatory element; including an element comprising SEQ ID NO:4, a complement thereof, a fragment thereof, a complement of said fragment, a nucleic acid that hybridizes to SEQ ID NO:4, or a nucleic acid that hybridizes to the complement of SEQ ID NO:4; and to a construct, a vector, and a plant comprising said element.

Group VII, claim(s) 7 (in part) and claim 6, 8-13, 23, and 25-26, drawn to a harvest-inducible regulatory element; including an element comprising SEQ ID NO:5, a complement thereof, a fragment thereof, a complement of said fragment, a nucleic

acid that hybridizes to SEQ ID NO:5, or a nucleic acid that hybridizes to the complement of SEQ ID NO:5; and to a construct, a vector, and a plant comprising said element.

Group VIII, claim(s) 7 (in part) and claim 6, 8-13, and 24-26, drawn to a harvest-inducible regulatory element; including an element comprising SEQ ID NO:6, a complement thereof, a fragment thereof, a complement of said fragment, a nucleic acid that hybridizes to SEQ ID NO:6, or a nucleic acid that hybridizes to the complement of SEQ ID NO:6; and to a construct, a vector, and a plant comprising said element.

Groups IX-XI, claim(s) 14-21, drawn to a method for production of a heterologous protein in a plant by transforming a plant with a construct comprising a specific harvest-inducible promoter; wherein the specific harvest inducible promoter for groups IX-XI is the promoter of groups VI-VIII, respectively.

2. The inventions listed as Groups I-XI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking groups I-XI is a harvest-inducible gene or a fragment thereof. Cramer et al. teach a harvest-inducible gene (see Figure 15 and Table 3) (Cramer et al. US Patent No. 5,670,349, issued on Sept. 23, 1997.)

Therefore, the technical feature linking the inventions of groups I-XI does not constitute a special technical feature as defined by PCT Rule 13.2 as it does not define a contribution over the prior art.

Accordingly, Groups I-XI are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

3. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly

admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cathy K. Worley whose telephone number is (571) 272-8784. The examiner is on a variable schedule but can normally be reached on M-F 10:00 - 4:00 with additional variable hours before 10:00 and after 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CKW

CYNTHIA COLLINS  
PRIMARY EXAMINER

*Cynthia Collins*  
3/5/07